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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Needle

Serial No. 76552569

John S. Mortimer of Wood, Phillips, Katz, Clark and
Mortimer for American Needle.

Kim Saito, Trademark Examining Attorney, Law Office 102
(Thomas V. Shaw, Managing Attorney).

Before Seeherman, Grendel and Zervas, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark CHICAGO STING (in standard character form) for
goods identified in the application as "men's, women's and
children's clothing, namely headwear including hats and
caps, pants, shirts, skirts, coats, jackets, shoes, and

accessories, namely belts.”¹ Pursuant to the Trademark Examining Attorney’s requirement, applicant has disclaimed the exclusive right to use the geographically descriptive term CHICAGO apart from the mark as shown.

At issue in this appeal is the Trademark Examining Attorney’s final refusal to register applicant’s mark on the ground that, as applied to applicant’s goods, the mark so resembles the mark depicted below,



previously registered on the Principal Register for goods identified in the registration as “clothing, namely, T-shirts, tank tops, sweat shirts, knit shirts, shorts, pants, woven shirts, sweaters, swimwear, hats and socks,” as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The appeal is fully briefed; no oral hearing was held. We affirm the refusal to register.

¹ Serial No. 765525569, filed September 29, 2003. The application is based on applicant’s asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find, under the second *du Pont* factor (the similarity or dissimilarity of the goods), that the goods identified in applicant's application are identical in part and otherwise highly similar to the goods identified in the cited registration. Applicant does not contend otherwise.

Under the third *du Pont* factor (similarity or dissimilarity of trade channels and classes of purchasers), we note that neither applicant's nor registrant's identification of goods is limited in any way, and we therefore presume that applicant's and registrant's goods are or would be marketed in all normal trade channels and to all normal classes of purchasers for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We find that applicant's

goods and registrant's identical or closely related goods are or would be marketed in the same trade channels and to the same classes of purchasers. Applicant does not contend otherwise.

Under the fourth *du Pont* factor (conditions of purchase), we find that the goods at issue here are general consumer items which would be purchased by ordinary consumers without a great degree of care or sophistication. Applicant does not contend otherwise.

Under the sixth *du Pont* factor, there is no evidence in the record showing third-party use of similar marks on similar goods; applicant's reliance on certain third-party registrations which were not made of record is to no avail.² The record does contain a printout of a third-party application, Serial No. 76413661, now abandoned, which is of the mark STING RACING (in standard character form; RACING disclaimed) for "clothing namely, shirts, T-shirts, tank tops, sweatshirts, jackets, shorts, pants, socks,

² The Trademark Examining Attorney informed applicant during prosecution that any third-party registrations must be properly made of record prior to appeal to be considered. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). Applicant never made them of record, either prior to or after its appeal. We agree with the Trademark Examining Attorney's contention that these registrations are not of record and can be given no consideration.

hats, visors and beanies."³ However, we find that this third-party application is not evidence of third-party use under the sixth *du Pont* factor. It does not appear that the STING RACING mark was ever used in commerce (the application was an intent-to-use application which was abandoned for failure to file a Statement of Use).

Moreover, even if the mark had been registered, the mere fact of its registration is not evidence of use of the mark in commerce under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

We turn finally to the first *du Pont* factor, i.e., whether applicant's mark and the cited registered mark are

³ The STING RACING application was filed on May 20, 2002, prior to the filing of applicant's present application on September 29, 2003 and prior to the November 25, 2002 filing date of the STING registration cited as a Section 2(d) bar in this case. The STING RACING mark was examined by the Trademark Examining Attorney handling the present application; the application which matured into the cited registered mark STING was examined by a different Trademark Examining Attorney. As applicant notes, this other Trademark Examining Attorney did not cite the prior-filed STING RACING mark as a potential Section 2(d) bar to registration of the cited registered mark STING. However, the present Trademark Examining Attorney originally cited the STING RACING application in the present case as a potential Section 2(d) bar to registration of applicant's CHICAGO STING mark. The STING RACING mark was approved for publication (by the present Trademark Examining Attorney), and a Notice of Allowance was issued after publication. The application subsequently was held abandoned due to the applicant's failure to file a Statement of Use, and the Trademark Examining Attorney thereafter withdrew her citation of it as a potential basis for refusal of applicant's mark in the present case.

similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles.

The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's goods are identical (in part) to the registrant's goods, the degree of similarity between the marks which is required to support a finding of likelihood

of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

We find, first, that the dominant feature in the commercial impression created by applicant's mark is the word STING, which is an arbitrary term as applied to applicant's (and registrant's) goods.⁴ The other element of applicant's mark, i.e., the word CHICAGO, is geographically descriptive (and disclaimed); while we do not disregard it, we find that it contributes relatively less to the commercial impression of the mark than does the arbitrary word STING. *See In re National Data, supra*. We also find that it is the word STING (rather than the stylized lettering in which it appears) which dominates the commercial impression of the cited registered mark.

⁴ The evidence of record includes the following dictionary definitions of "sting" from Webster's Ninth New Collegiate Dictionary, submitted by applicant:

vt **1** : to prick painfully: as **a** : to pierce or wound with a poisonous or irritating process **b** : to affect with sharp quick pain or smart <hail *stung* their faces> **2** : to cause to suffer acutely <*stung* with remorse> **3** : OVERCHARGE, CHEAT ~ vi **1** : to use a sting **2** : to feel a keen burning pain or smart

n **1** : the act of stinging; *specif* : the thrust of a stinger into the flesh **b** : a wound or pain caused by or as if by stinging **2** : STINGER **2** **3** : a sharp or stinging element, force, or quality **4** : an elaborate confidence game; *specif* : such a game worked by undercover police in order to trap criminals

In terms of appearance and sound, we find that applicant's mark and the cited registered mark are similar to the extent that they both include the word STING, but dissimilar to the extent that applicant's mark also includes the word CHICAGO. Although the cited registered mark depicts the word STING in stylized lettering, that fact does not suffice to legally distinguish the marks in terms of appearance because applicant seeks registration of its mark in standard character form, which would entitle applicant to display the mark in a variety of lettering styles, including a style similar to that of the cited registered mark. Viewing the marks in their entirety in terms of appearance and sound, we find that they are more similar than dissimilar. That is, the similarity which results from the presence in both marks of the arbitrary word STING outweighs the points of dissimilarity, i.e., the presence of the word CHICAGO in applicant's mark and the stylized lettering of the cited registered mark.

Viewing the marks in their entirety in terms of connotation and overall commercial impression, we again find them to be more similar than dissimilar. STING is an arbitrary term as applied to applicant's and registrant's goods, and it has the same arbitrary connotation in both marks. Applicant argues, however, that CHICAGO STING

presents a unitary connotation and commercial impression which is lacking in the cited registered mark, because CHICAGO STING "was the name of a now defunct North American Soccer League team that operated from 1975 to 1984, and indeed won the NASL championship in 1984." (Reply brief at 3.) In support of this contention, applicant has submitted a printout of an Internet web page⁵ captioned "Sting Team Page" which includes a design logo reading "Chicago Sting" and the wording "Chicago Sting 1975-1984," along with various statistics and other information about the team.

The evidence of record simply does not support a finding that purchasers will readily perceive applicant's mark as a unitary mark comprising the name of a now defunct soccer team. There is no evidence as to the degree of recognition the team and its name enjoyed while it was competing, much less that purchasers today, over twenty years later, will recognize CHICAGO STING as the name of such team.

Moreover, we agree with the Trademark Examining Attorney's contention that even if applicant's mark is perceived as the name of a sports team, it is common for such teams to be referred to simply by the team name, i.e.,

⁵ <http://home.att.net/~nasl/teams/sting.htm>

without the geographical designation preceding the team name. Thus, the Chicago Sting soccer team would likely be referred to simply as the "Sting," which is identical to the cited registered mark. Purchasers who are aware of the team would be likely to assume that clothing products bearing the registrant's mark STING are somehow related to or sponsored by the "Chicago Sting" team. Section 2(d) bars registration of marks which are likely to cause reverse confusion such as this.

In short, we find that applicant's mark and the cited registered mark are similar rather than dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Applicant notes that the Office approved for publication both the cited registered mark STING & design and the prior-filed mark STING RACING, for identical or similar goods. (See discussion *supra* at footnote 3.) However, we are not privy to the reasons why the Office (by a different Trademark Examining Attorney) allowed the STING & Design mark to register despite the existence of the prior-filed application to register STING RACING, nor are we bound by that determination. Although consistency of

examination is a goal of the Office, we must decide each case on the facts as presented in the record before us.

In this case, considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists. Applicant's mark prominently includes the strong and arbitrary designation STING, which also comprises the essence of the cited registered mark. The two marks are sufficiently similar that confusion is likely to result from their use on the identical goods involved herein, which are presumed to move in the same trade channels and to the same classes of ordinary purchasers. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.